

Pleyer is Disqualified as Prior Art under 35 U.S.C. § 103(c)

35 U.S.C. §103(c) states that “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Applicant’s application was filed on July 29, 1997. For purposes of application of §102(e), this date is treated by the Patent Office as the invention’s constructive reduction to practice date. Pleyer was filed on September 25, 1996. Pleyer qualifies as prior art under 35 U.S.C. §102(e), with respect to Applicant’s constructive reduction to practice date, because it is a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.

Additionally, Pleyer is assigned to Microsoft Corporation. The present application is assigned to Microsoft. At the time that the claimed invention was made, Pleyer and the subject matter of the claimed invention were owned by the same “person” (i.e. Microsoft).

In addition, however, MPEP 706.02(l)(1) states that, for applications filed prior to November 29, 1999 (the date that §102(e) art became subject to disqualification under §103(c) for commonly owned subject matter), the mere filing of a continuing application (including those filed as continued prosecution applications under Rule 1.53(d)) on or after November 29, 1999 will serve to exclude commonly owned §102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. §103 in the parent application.

1 Accordingly, Applicant has filed the present application as a CPA. Therefore,
2 under §103(c), Pleyer is disqualified as prior art and the § 103 rejection must be
3 withdrawn.

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5 **Conclusion**

6 Applicant submits that all of the claims are in condition for allowance and
7 respectfully requests a Notice of Allowability be issued forthwith. If the Office's
8 next anticipated action is to be anything other than issuance of a Notice of
9 Allowability, Applicant respectfully request that the undersigned be contacted for
10 the purpose of scheduling an interview.

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12 Respectfully Submitted,

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14 Dated: 7/25/01

15 By: 

16 Lance R. Sadler
17 Reg. No. 38,605
18 (509) 324-9256
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